

## **RESPONSE**

Claims 1 and 4-41 are pending in the application. Claims 1, 19, 27 and 39 are independent format.

### **Information Disclosure Statement**

The Applicant acknowledges and thanks the Examiner for considering all items listed on the IDS filed August 27, 2001.

### **Previous Arguments**

The Applicant acknowledges that the Examiner has withdrawn rejection under 35 U.S.C. 102(e) as being anticipated by Scott et al. U.S. Patent No. 5,675,752.

### **Section 103(a) Rejection**

The Examiner rejects claims 1 and 4-41 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,675,752 to Scott et al. (Scott) in view of U.S. Patent No. 5,973,692 to Knowlton et al. (Knowlton).

The Applicant traverses this assertion. The Applicant may respond only to specific statements in the Examiner's assertions. However, the Applicant intends to traverse all the Examiner's assertions.

### **Section 103(a) Response**

#### **Claim 1**

Claim 1 has been modified to further clarify the invention. Even though the invention functions are implicitly automatic, the Applicant has added the word *automatic* to further clarify the invention.

The Applicant accepts the Examiner's *admission* that Scott explicitly fails to teach the first claim element of Claim 1 comprising "capturing one or more graphical representations of one or more portions of information content of one or more computer files while an application is manipulating the one or more computer files."

The Examiner is reminded that to establish a case of *prima facie* obviousness of a claimed invention in the first place, all of the claim limitations must be taught or suggested. *In re Royka* 400 F.2d 981 (CCPA 1974).

The second claim element Claim 1 recites "creating an icon including selected portions of the captured one or more graphical representations of the information content of the one or more computer files wherein the icon graphically depicts at least a portion of the information content from the one or more computer files."

Since this second claim element includes information obtained from the first claim element the Examiner admits that Scott does not explicitly teach, Scott does not teach at least two of the claim elements of Claim 1. Thus, Scott alone (or in combination with Knowlton) cannot teach all of the claim limitations of Claim 1 under the holding of *In re Royka*.

In addition, the Examiner asserts that Scott explicitly teaches the second element of Claim 1 at Col. 11, lines 5-51. However, with respect to icons, the only thing Scott teaches in that section is that "icons are used to represent commonly used functions such as the rules checker and the applications tester." (Col. 11, lines 15-17). Nowhere in Col. 11 at lines 5-51 does Scott teach, suggest or even mention creating an icon with the characteristics taught by the first two elements of Claim 1.

The Applicant respectfully request the Examiner specifically point out the exact lines in Col. 11 where Scott supposedly teaches the first two elements of Claim

1. The Applicant submits that Scott does not teach or suggest the first two claim elements of Claim 1 and therefore is not obvious under the holding of *In re Royka*.

In addition, the Applicant can not find anywhere in Scott where Scott teaches that icons are created period. If the Examiner is still asserting that Scott teaches creating icons based on information content of one or more files, the Applicant respectfully requests the Examiner specifically point out the exact lines in Scott where Scott allegedly teaches creating icons at all.

The Examiner then asserts that “it would have been obvious to one of ordinary skill in the art, having the teachings of Scott and Knowlton before him at the time the invention was made to modify the interactive application of Scott to include the system to capture graphical representations as taught by Knowlton in order to capture and generate a corresponding graphical icon forming a displayable image representing the graphics information.”

The Examiner is reminded that to establish a *prima facie* case of obviousness based on the combination of references, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

(1) **No suggestion or motivation to combine:** The Examiner is reminded that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then *there is no suggestion or motivation to make the proposed modification*. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Scott teaches at Col. 2, lines 1-6, “It is a further object of the present invention to decouple the user interface portion of multimedia display screens from the interactive media portion.” In direct contrast, Knowlton teaches a method to couple a user interface with interactive media portion by creating visual links and teaches at Col. 10, lines 45-48 teaches “a visual link 142 will include a Universal Resource Locator (URL) 128 and may include a Title 130, a Text 132, and a Date 134 and may include Keywords 136” and at Col. 12 lines 49-51 teaches that visual links “allow a user to access the target of a visual link.” See also Abstract.

Thus, Scott teaches decoupling a user interface from the underlying media and Knowlton teaches creating a coupling with a visual link for a user interface to underlying media. This is a direct conflict for combining the two references.

Further Scott teaches Col. 11, lines 15-17 “In addition, the GUI for the interactive presentation editor contains a tool bar 318 containing a number of icons. The icons are used to represent commonly used functions such as the rules checker and the applications tester.” In direct contrast Knowlton teaches at Col. 8 lines 47-50 and Col. 10, lines 55-62 visual links

142 include graphical icons 144 used for indexing and displaying information accessible across or through a network. The graphical icons are manually created by a user to allow access to information other than system tools such as rules checkers and applications testers taught by Scott.

Thus, the Examiner's proposed modification by incorporating the teachings of Knowlton into Scott would render Scott invention unsatisfactory for at least two of its intended purposes, namely decoupling the user interface portion of multimedia display screens from the interactive media portion and using icons to represent commonly used system functions such as rules checkers and applications testers on a toolbar. Therefore, *there is no suggestion or motivation* to make the proposed modification under the holding of *In re Gordon*.

Finally, even if Scott and Knowlton could be combined, which they can't based on the above discussion, the combination still does not teach or suggest all of the claim limitations recited by Claim 1. Therefore, Claim 1 cannot be obvious over the combination of Scott and Knowlton.

**(2) No reasonable expectation of success of combination:**

The Examiner is reminded that evidence supporting *no reasonable expectation of success* of combining two references supports a conclusion of non-obviousness; *In re Reinhart*, 531 F.2d 1048 (CCPA 1976).

The Examiner is reminded that the mere fact that the references can be combined or modified (which is not the case in this matter) does not render the resultant combination obvious unless the prior art also suggests

the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

The Examiner is finally reminded that if the proposed modification or combination of the prior art would change the principal operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti* 270 F.2d 810 (COPA 1959).

Scott teaches at Col. 2, lines 1-6, "It is a further object of the present invention to decouple the user interface portion of multimedia display screens from the interactive media portion." This does not teach or suggest allowing combination with Knowlton.

Scott teaches at Col. 7, lines 10-21 a computer system for generating a window-based graphic user interface. Scott teaches at Col. 8, 32-44 "The present invention permits generation of customized interactive applications environments through use of an interactive applications generator. The interactive applications generator provides a means for a user to create a customized interactive applications environment for a particular application. For example, an interactive applications environment may be generated for an airline passenger entertainment system. Specifically, the interactive applications generator permits generation of customized logos, background colors and textures, graphical design style of controls including buttons and sliders, and a generalized look and feel of a graphical user interface for a particular application."

In direct contrast Knowlton teaches at Col. 2, lines 35-37 teaches “The present invention is directed to a visual link mechanism residing in a local system for identifying addresses of locations in the plurality of remote systems” and at Col. 3, lines 10-13 teaches “According to the present invention, the visual link mechanism further includes a link for relating the graphic icon and the visual link dataset” and at Col.8, lines 30-39 teaches “As described above, the present invention is a system and a method and apparatus for the graphical representation of bodies or sources of information, such as files or internet or Web locations, and ...indexing and accessing the bodies or sources of information. The following will first describe a presently preferred embodiment of a system for indexing and displaying and accessing information on the World Wide Web, hereafter referred to as the Web.”

Scott teaches a tool for creating customized interactive applications environments such as airline passenger entertainment systems that decouples the user interface portion of multimedia display screens from the interactive media portion. In direct contrast Knowlton teaches creating visual links used on a user interface for accessing bodies or sources of information on the Internet. Both teach complicated systems with many specific design and implementation architectures.

Therefore, there is no reasonable expectation of success to combine Scott and Knowlton technically or otherwise. The two inventions are used

for two totally different purposes. Thus, the combination does not render Claim 1 obvious under the holding of *In re Reinhart*.

With these fundamental differences in design, architecture and how the inventions functions, neither Scott nor Knowlton teach or suggest a desirability to combine the functionality of both inventions. In fact, both references teach away from such a combination. Thus, the combination does not render Claim 1 obvious either under the holding of *In re Mills*.

The modification or combination of Scott to including Knowlton would change the principal operation of the of Scott so, the teachings of the references are not sufficient to render Claim 1 *prima facie* obvious under the holding of *In re Ratti* either.

Finally, even if Scott and Knowlton could be combined, the combination still does not teach or suggest all of the claim limitations recited by Claim 1. Therefore, Claim 1 cannot be obvious over the combination of Scott and Knowlton.

**(3) Not all the claim elements are taught or suggested:**

The Examiner *admitted* that Scott did not teach the first element of Claim 1 (and therefore Scott also cannot teach the second claim element because it includes information obtained from the first claim element).

Therefore, Scott does not teach at least two of the claim elements of Claim 1.

The Examiner is also reminded that a *prima facie* case of obviousness can be rebutted by showing that the prior art, in any material respect



teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465 (Fed.

Cir. 1997).

The Examiner then asserts that Knowlton teaches the first element of Claim 1 at Col. 10, lines 10-60).

However, Knowlton instead teaches something very different from the claimed invention. Knowlton instead teaches at Col. 16, lines 10-20 “A Visual Links Visual Link Capture Engine 138 for selecting areas of graphics images and forming them into Graphic Icons 144 must meet a number of requirements and must provide a number of functions. For example, the Visual Link Capture Engine 138 must provide an evaluation procedure and mechanism for comparing the worth, that is, the visual strength, of various proposed regions of an image, and at least affirming the validity of a region of an image as a source of image information for a Graphic Icon 144.”

One of these requirements that must be met is taught At Col. 14, lines 16-33 where Knowlton teaches “Visual Link Capture Engine 138 may perform this operation in a number of ways, for example, providing a user with a mechanism to manually delineate and copy an area of an image, such as an area of an HTML page or document or other form of graphic image, to comprise the graphic information that is used to create a Graphic Icon 144. Such mechanisms are commonly known and implemented using, for example, the required operations available in the Microsoft Windows operating environment and used, for example, in Microsoft Paint and similar drawing programs. This approach may be used, for example, in an

implementation of Visual Link Capture Engine 138 used in Local System 112, and designated in FIG. 1A as Visual Links Manual Capture Engine 138M, where a user is creating Visual Links 142 for a relatively small number of HTML documents or pages or a relatively small number of other image files.”

Thus, Knowlton explicitly teaches that one of the requirements that must be met and one of the functions that must be used is that a user must be able to manually delineate and copy an HTML page or document with Microsoft Paint or other similar drawing programs. The claimed invention does not require such manual user interactions using Microsoft Paint or other similar drawing programs to create a graphical icon.

Knowlton further teaches at Col. 14 lines 36-45 that “A user may also, as an alternative or in combination with such operations, create a part of or the entirety of the visual image by the graphics operations of such a graphics application program or utility, or by selection of a part of or the entirety of the visual image from an independent library of images, and may modify an image or a part of an image selected from a library of images for such purposes. In such cases, the image part of a Visual Link 142 is thereby not derived, at least not totally, from the imagery of an HTML image.”

This also teaches away from the claimed invention which first does not require manual intervention by a user to create a graphical icon by using drawing tools or graphical icons. In addition, this *teaches away* from the claimed invention as the graphical icon created in the claimed invention *does*

include information derived from the files it is manipulating not other information manually selected by a user from independent images or library files that may have no relation to the information content of the one or more files.

Knowlton also teaches at Col. 14, lines 46-51 "that it has been found preferable, in the presently preferred embodiment, that the dimensions and aspect ratios of the Graphic Icons 144 be selected to allow efficient packing into a given display area." And teaches at Col. 14, lines 63 through Col. 15, line 20 that a user manually selects the dimensions. "For example, the user may be provided with a mouse controlled "stretchy rectangle" to use in selecting a portion of the original image for possible use in generating a Graphic Icon 144, in the manner well known, for example, in Microsoft Windows graphics programs such as the Microsoft Paint program. The Graphic Icons 144 generation program would then display one or more representations of the Graphic Icons 144 that could result from the use of the area delineated by the user, thereby allowing the user to select one of the possible Graphic Icons 144 that would result from that selection. In another embodiment, and as illustrated in FIG. 1D, the user would use, for example, the mouse cursor to designate one corner, such as the upper left corner, of an area of the original image and the Graphic Icon 144 generation program would overlay and display on the original image a set of rectangles representing the set of possible Graphic Icons 144 wherein the set of rectangles conform to the range of dimensions and aspect ratios selected for

the Graphic Icons 144, the upper left corner of each of the displayed rectangles being located at the initial point designated by the user. The user could then select one of the displayed rectangles as delineating the area of the original image to be used in generated the Graphic Icon 144, for example, by "clicking" on the lower right corner of the chosen rectangle."

This teaches away from the claimed invention which does not require manual intervention or using Microsoft Paint by a user to create a graphical icon.

Knowlton further teaches on of the requirements and functions at Col. 15, lines 37-54 "Visual Link Capture Engine 138 as implemented in Server System 114, however, will preferably provide an automatic mechanism, designated in FIG. 1A as Visual Links Visual Link Capture Engine 138, for selecting areas of graphics images and forming them into Graphic Icons 144 because the large number of Visual Links 142 that must be generated. It may also be desirable to provide an implementation of Visual Links Visual Link Capture Engine 138 for use in Local System 112, however, for example, when a user generally lacks the skill, interest or time to create Visual Links 142 manually. Such visual links may, for example and in one possible implementation, be held only temporarily, for example, for the duration of a session...."

Thus, Knowlton teaches that even if the system creates visual links automatically, but does not teach or suggest creating icons automatically without manual input by a user with graphics tools. In addition, if such

visual links are created automatically, then such visual links and corresponding icons are only held temporarily for the duration of user session. This teaches away from the claimed invention which does not create temporary icons.

Similarly Knowlton teaches at Col. 11, lines 25-36 "It will also be noted that Graphic Icons 144 need not be generated from an HTML document by a Visual Links Automatic Capture Engine 138A, but may be generated independently by a user of a Local System 112 or the operators of a Server System 114 or a Web Server 118, or even by an independent supplier of pre-made Graphic Icons 144 using, for example, virtually any of a wide range of well known and readily available graphics creation programs, and may be used subsequently in the construction of Visual Links 142 or, for example, to replace an already existing Graphic Icon 144 associated with a Visual Link 142."

This also teaches away from the claimed invention which does not include graphical icons generated independently by a user of a local system or obtained from an independent supplier of pre-made graphic icons or created from readily available graphics creation programs instead of from files that being manipulated. Instead the claimed invention creates icons that include information content of files being manipulated by an application to allow a user to visually see a portion of the contents of the information file.

Thus, Knowlton does not teach or suggest the first element of Claim 1.

Neither Knowlton alone, nor the combination of Knowlton and Scott still do not teach or suggest all of the limitations of Claim 1. Therefore Claim 1 cannot be obvious under the holding of *In re Royka*.

Scott cannot teach the remaining elements of Claim 1 since the Examiner has admitted that Scott does not teach the first element of Claim 1, that automatically captures information for automatically creating an icon since several of the remaining claim elements include the automatically created icon.

Finally, even if Scott and Knowlton could be combined, the combination still does not teach or suggest all of the claim limitations recited by Claim 1. Therefore, Claim 1 cannot be obvious over the combination of Scott and Knowlton.

**(4) Conclusion:** The Applicant has illustrated that (1) there was no some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine Scott with Knowlton. Second, based on the differences in architecture and functionality there would be no reasonable expectation of success to combine Scott and Knowlton technically or otherwise. Finally, the prior art references, alone or in combination, did not teach or suggest all of the claim limitations of Claim 1. Therefore, the Examiner has not established a *prima facie case* of obviousness to combine Scott and Knowlton under the holdings of *In re Vaeck*.

**CLAIMS 4-41:**

The arguments for independent Claim 1 above are incorporated by reference for the other independent claims 19, 27 and 39 and remaining dependent Claims.

Independent claims 19, 27 and 39 have been amended to include additional elements not taught by Scott or Knowlton alone, nor the combination thereof.

The dependent claims include additional limitations not recited by the independent claims. The Examiner is reminded that if an independent claim is nonobvious under 35 U.S.C. 103, than any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Thus, the dependent claims are not obvious and the rejections of dependent claims improper.

Therefore the rejection of Claims 4-41 must be immediately withdrawn.

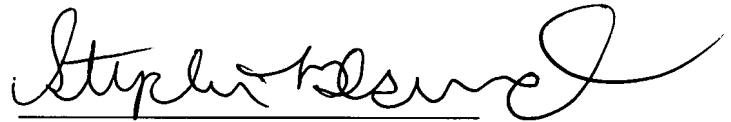
**CONCLUSION**

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited reference for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §103(a) rejections of the claims and pass all of the claims to allowance.

Respectfully submitted.

**Lesavich High-Tech Law Group, PC (32097)**

Dated: April 9, 2007

A handwritten signature in cursive script, appearing to read "Stephen Lesavich", written in black ink.

Stephen Lesavich, PhD

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